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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/809,158

03/25/2004

Pelegrin Torres JR.

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THE DIRECTV GROUP INC

PATENT DOCKET ADMINISTRATION RE/R11/A109

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EXAMINER

SIPOS, JOHN

ART UNIT

PAPER NUMBER

3721

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/06/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/809,158		TORRES, PELEGRIN	
	<b>Examiner</b>		<b>Art Unit</b>	
	John Sipos		3721	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-36 is/are pending in the application.  
     4a) Of the above claim(s) 14-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-13 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

### ***REJECTIONS OF CLAIMS BASED ON PRIOR ART***

**Claims 1,3-9,11-13 and 36** are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over Admitted Prior Art (APA) of pages 1-3 of the instant specification in view of the patent to Limelette (6,899,276). The APA comprises the placing of a Smart Card having a bar code in an envelope that is preprinted with a license agreement and then sealing the envelope. The envelope has a window that makes the bar code visible without opening the envelope. The opening of the preprinted envelope indicates acceptance of the agreement by the customer. This APA lacks the use of a film for the packaging and lacks the use of a licensing agreement that is larger than the footprint of the package. The patent to Limelette shows the wrapping of a data-encoded card in a polypropylene film that comprises a window portion to provide visibility of the card. In view of the teaching of Limelette it would have been obvious to one skilled in the art to use a film to package the Smart Card of the APA instead of the paper envelope to form a cheaper and a more easily mass-produced package.

The specific size of the licensing agreement relative the card and the film (claims 1,4,5 and 13) are matters of experimentation as to the most cost effective and optimum package. For example, the reducing the size of a package lowers the cost of the packaging material. Since the use of license agreement on the exterior of a package is known (as taught by the APA) and since the use of exterior printing on both the front and back of packages are known as well (e.g. compact disk packages, books), it would have been obvious to one skilled in the art to continue the license agreement printed on the front of a package on the back of the package if it is longer than the dimensions of the package.

The use of magazine to hold a plurality of cards and to feed them one at a time to the processing station (claims 9 and 36) and the use of anti-static means to remove static from a material (claim 13) are well known in the art and the Examiner takes official notice that their use is common knowledge in the packaging art. In the above cases the modification of the APA operation would have been obvious to one skilled in the art for the known benefits of each modification. For example, feeding cards out of a magazine increases the efficiency of the operation and the use of anti static means reduces damage to cards carrying data chips.

Regarding claim 11, the printing of dark text against light background regardless of the material is well known in the packaging art and one such example is the APA envelope and using the same concept on a film would have been obvious to one skilled in the art to make the print more legible.

**Claim 10** is rejected under **35 U.S.C. ' 103(a)** as being unpatentable over Admitted Prior Art (APA) of pages 1-3 of the instant specification in view of the patent to Limelette (6,899,276) and in view of the Admitted Prior Art 2 (APA2).

As was stated in the last Office action, the examiner considers the use of spines on packages well known and took Official Notice of such use. Therefore, it would have been obvious to one skilled in the art to provide the Smart Card package with a spine to provide for easier access and grasping of the package. In view of these assertions made by the Examiner in the last Office action and Applicants silence regarding them, the motion sensor feature is considered as an admission of prior art.

**Claims 1,2-9, 11-13 and 36** are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over Admitted Prior Art (APA) of pages 1-3 of the instant specification in view of the patent to

Roshkoff (6,042,149) or alternatively, Roshkoff (6,042,149) in view of Admitted Prior Art (APA) of pages 1-3 of the instant specification.

The APA comprises the placing of a Smart Card having a bar code in an envelope that is preprinted with a license agreement and then sealing the envelope. The envelope has a window that makes the bar code visible without opening the envelope. The opening of the preprinted envelope indicates acceptance of the agreement by the customer. This APA lacks the use of a film for the packaging and lacks the use of a licensing agreement that is larger than the footprint of the package.

The patent to Roshkoff shows the wrapping of a Smart Card 18 in transparent plastic film 10 that provides visibility of bar code printed on the Smart Card and with the exterior surface of the film 14 carrying printed matter.

In view of the teaching of Roshkoff it would have been obvious to one skilled in the art to use a film to package the Smart Card of the APA instead of the paper envelope to form a cheaper and a more easily mass-produced package.

Alternatively, it would have been obvious to one skilled in the art to print a license agreement on the exterior surface of the film of Roshkoff as taught by APA which would minimize the cost of using extra materials in the package.

The specific size of the licensing agreement relative the card and the film (claims 1,4,5 and 13) are matters of experimentation as to the most cost effective and optimum package. For example, the reducing the size of a package lowers the cost of the packaging material. Since the use of license agreement on the exterior of a package is known (as taught by the APA) and since the use of exterior printing on both the front and back of packages are known as well (e.g.

compact disk packages, books), it would have been obvious to one skilled in the art to continue the license agreement printed on the front of a package on the back of the package if it is longer than the dimensions of the package.

Regarding claims 6 and 7, since the Roshkoff package uses transparent film through which the bar code is visible, the “window” of these claims is read on the transparent nature of the film.

The use of windows in packages to permit visibility of indicia such as bar codes (claim 8), the use of a magazine to hold a plurality of cards and to feed them one at a time to the processing station (claims 9 and 36) and the use of anti-static means to remove static from a material (claim 13) are well known in the art and the Examiner takes official notice that their use is common knowledge in the packaging art. In the above cases the modification of the APA operation would have been obvious to one skilled in the art for the known benefits of each modification. For example, windows permit the visibility of only portions of the contents, feeding cards out of a magazine increases the efficiency of the operation and the use of anti static means reduces damage to cards carrying data chips.

Regarding claim 11, the printing of dark text against light background regardless of the material is well known in the packaging art and one such example is the APA envelope and using the same concept on a film would have been obvious to one skilled in the art to make the print more legible.

**Claim 10** is rejected under **35 U.S.C. ' 103(a)** as being unpatentable over Admitted Prior Art (APA) of pages 1-3 of the instant specification in view of the patent to Roshkoff (6,042,149)

or alternatively, Roshkoff (6,042,149) in view of Admitted Prior Art (APA) of pages 1-3 of the instant specification, and further in view of the Admitted Prior Art 2 (APA2).

As was stated in the last Office action, the examiner considers the use of spines on packages well known and took Official Notice of such use. Therefore, it would have been obvious to one skilled in the art to provide the Smart Card package with a spine to provide for easier access and grasping of the package. In view of these assertions made by the Examiner in the last Office action and Applicants silence regarding them, the motion sensor feature is considered as an admission of prior art.

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***ADDITIONAL REFERENCES CITED***

The following prior art is made of record but has not been relied upon in the rejection of claims. However, the prior art is considered pertinent to applicant's disclosure.

The patent to Bagdis shows the printing of license agreements on the exterior of a package.

The patent to Dawson shows the packaging of Smart Cards in film 203 having a window 103 that allows visibility of a bar code on the Smart Card but which is smaller than the card.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **571-272-4468**. The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.

The **FAX** number for U.S. Patent and Trademark Office is **(571) 273-8300**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at **571-272-4467**.



**John Sipos**  
**Primary Examiner**  
Art Unit 3721